UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,009	12/26/2001	Yuichi Takatsu	65316-0008	2437

10291	7590	02/07/2007

RADER, FISHMAN & GRAUER PLLC
39533 WOODWARD AVENUE
SUITE 140
BLOOMFIELD HILLS, MI 48304-0610

EXAMINER
LASTRA, DANIEL

ART UNIT	PAPER NUMBER
3622	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/036,009	TAKATSU, YUICHI
	Examiner	Art Unit	
	DANIEL LASTRA	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 November 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-16 and 18-21</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-16 and 18-21</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>04/26/2006</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-16 and 18-21 have been examined. Application 10/036,009 (ELECTRONIC SETTLEMENT APPARATUS ELECTRONIC SETTLEMENT METHOD, STORAGE MEDIUM AND COMPUTER DATA SIGNAL) has a filing date 12/26/2001 and foreign priority 12/28/2000.

Response to Amendment

2.   In response to Non Final Rejection filed 05/02/2006, the Applicant filed an Amendment on 11/02/2006, which amended claims 1 and 18-21.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 and 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims recite "temporary balance data is temporarily stored in said memory before said settlement data is supplied to said processor". For purpose of art rejection, said limitation would be interpreted as meaning checking if there are sufficient points in a memory in order to settle a transaction with said points. Claims 1 recites "when settlement data, which represents that settlement of purchase of said goods is completed, is supplied, said processor decides that goods represented by said goods data is good that said user will purchase and updates, in response to the decision of goods that said user will purchase, said discount points

stored in said memory according to the result represented by said temporary balance whereby said temporary balance is temporarily stored in said memory before said settlement data is supplied to said processor". Said claim 1 is indefinite because it is not clear when the settlement data occurs and it is not clear when the balance in memory is updated. Furthermore, it is not clear about the difference between discount points and use points when it mentions "subtracting the discount points designated by use point data from discount points decided to be newly assigned". Claim 8 is not clear the difference between settlement points and discount points. Claim 11 is indefinite because it recites that discount points represent use point data and then goes to say that said discount points needs to be more than predetermined available points to be discount points making unclear if they are or not discount points. Claims 18-21 are indefinite because it is not clear the linkage between settlement data and the temporary balance. It is unclear the time when the settlement data occurs and the time when temporary balance is updated.

Claim 9 recites the limitations "said memory conversion rate data" and "said settlement points". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,

except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 and 18-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Breck (US 2004/0210449).

As per claims 1 and 19-21, Breck teaches:

An electronic settlement apparatus comprising:

memory for storing discount points representing a property value to be associated with a user to which the said discount points are assigned (see paragraph 102); and

a processor, wherein said processor obtains goods data that designates goods and use point data that designates an amount to be appropriated for the price of the said goods, decides the discount points to be newly assigned to said user based on said obtained goods data,

generates temporary balance data representing a result obtained by varying the discount points stored in said memory by amount corresponding to a value obtained by subtracting the discount points designated by use point data from the discount points decided to be newly assigned to said user (see paragraphs 106-107),

and when settlement data, which represents that settlement of purchase of said goods is completed, is supplied, said processor decides that goods represented by said goods data is goods that said user will purchase and updates, in response to the decision of goods that said user will purchase, said discount points stored in said

memory according to the result represented by said temporary balance data (see paragraphs 101-107);

whereby said *temporary balance data is temporarily* stored in said memory *before* said settlement data is supplied to said processor (see paragraph 106). Breck teaches storing points in a temporary point account (i.e. "MR-STN account") before the settlement of said points, similar to Applicant's specification page 6, lines 8-20).

As per claim 2, Breck teaches:

The electronic settlement apparatus according to claim 1, further comprising a receiving server for obtaining said goods data and said use point data from an external section via a network so as to be transferred to said processor, wherein said processor obtains said goods data and said user point data transferred from said receiving server (see paragraph 103).

As per claim 3, Breck teaches:

The electronic settlement apparatus according to claim 1, wherein said memory stores user identification data that identifies the user to which said discount points are assigned to be associated with said discount points, and a password associated with the said user identification data (see paragraph 105); and

said processor obtains information and password representing said user; determines whether or not said memory stores said user identification data that identifies the user represented by said obtained information and said obtained password to be associated with each other; and stops obtaining said goods data or said user point

data when determining that said memory stores neither user identification data nor said

password to be associated with each other (see paragraph 105).

As per claim 4, <u>Breck</u> teaches:

The electronic settlement apparatus according to claim 3, wherein said processor

obtains information, which is supplied from an external section and which represents the

user, in accordance with an instruction supplied from the external section, and

generates said user identification data that identities the user represented by obtained

information and said password associated with the said user identification data, and

store said user identification data and password in said memory (see paragraph 105).

As per claim 5, <u>Breck</u> teaches:

The electronic settlement apparatus according to claim 3, wherein said memory

stores user information unique to the user identified by said corresponding user

identification data to be associated with said user identification data (see paragraph

105).

As per claim 6, <u>Breck</u> teaches:

The electronic settlement apparatus according to claim 5, wherein when said

processor determines that said user identification data that identities the user

represented by said information obtained by the processor and said password obtained

by the processor are stored in said memory to be associated with each other, said

processor updates said user information stored in grid memory to be associated with

the said user identification data to user information supplied from the external section

(see paragraph 105).

As per claim 7, <u>Breck</u> teaches:

The electronic settlement apparatus according to claim 1, wherein when said processor determines whether or not said settlement data is supplied to the processor until a predetermined time has elapsed after obtaining goods data, and when said processor determines that no settlement data is supplied thereto, said processor abandons the obtained corresponding goods data (see paragraph 105).

As per claim 8, <u>Breck</u> teaches:

The electronic settlement apparatus according to claim 1, further comprising a settlement server, wherein said settlement server stores settlement points representing a property value to be associated with identification data unique to the said settlement points (see paragraph 103);

determines whether or not said processor obtains said goods data and said use point data; obtains said identification data from the external section when it is determined that said processor obtains said goods data and said use point data, decides that a difference between an amount of settlement points corresponding to the price of goods represented by said goods data and an amount of settlement points corresponding to the discount points represented by said use point data is appropriated for the price of the said goods; and supplies said settlement data to said processor when the settlement points associated with 5 said obtained identification data are more than said difference (see paragraphs 103-107).

As per claim 9, <u>Breck</u> teaches:

The electronic settlement apparatus according to claim 1, wherein said memory stores conversion rate data representing a conversion rate between said discount points and said settlement points, and said processor specifies the amount of settlement points corresponding to the discount points represented by said use point data according to the conversion rate represented by said conversion rate data (see paragraph 106).

As per claim 11, Breck teaches:

The electronic settlement apparatus according to claim 1, wherein said processor determines whether or not the discount points represented by the use point data obtained by the processor are more than predetermined available points, and handles the said available points as discount points (see paragraph 106).

As per claim 12, Breck teaches:

The electronic settlement apparatus according to claim 2, wherein said receiving server supplies goods data and use point data obtained by said receiving server to said processor via a LAN (Local Area Network); and said processor decides discount points to be newly assigned to said user based on the price of said goods data supplied from said receiving server, and updates said discount points stored in said memory to be varied by an amount corresponding to a value obtained by subtracting the discount points designated by use point data supplied from said receiving server from the discount points (see paragraphs 103-107).

As per claim 13, Breck teaches:

The electronic settlement apparatus according to claim 2, wherein said receiving server supplies goods data and use point data obtained by said receiving server to said processor via a WVW (World Wide Web); and said processor decides discount points to be newly assigned to said user based on the price of said goods data supplied from said receiving server, and updates said discount points stored in said memory to be varied by an amount corresponding to a value obtained by subtracting the discount paints designated by use point data supplied from said receiving server from the discount points decided by said processor (see paragraphs 103-107).

As per claim 14, <u>Breck</u> teaches:

The electronic settlement apparatus according to claim 13, wherein said receiving server venerates order identification data unique to each goods data obtained by said receiving server so as to be supplied to said processor, and supplies reception identification data unique to said receiving server to said processor to be associated with said goods data (see paragraphs 103-107).

As per claim 15, <u>Breck</u> teaches:

The electronic settlement apparatus according to claim 1, wherein said memory stores assignment rate data that designates discount points to be newly assigned to said user per unit quantity of the price of said goods; and said processor decides a value obtained by multiplying the price of goods represented by goods data obtained by the processor by the discount points designated by said assignment rate data as discount points to be newly assigned to said user (see paragraph 106).

As per claim 16, <u>Breck</u> teaches:

The electronic settlement apparatus according to claim 1, wherein said goods data includes point designation information that designates discount points to be assigned to a person who purchases goods represented by the said goods data; and said processor decides the discount points represented by said point designation information included in said goods data obtained by said processor as discount points to be newly assigned to said user (see paragraph 106).

As per claim 18, Breck teaches:

An electronic settlement apparatus comprising:

a receiving server for obtaining goods data that designates goods and use point data that designates an amount to be appropriated for the price of the said goods in the discount points representing a property value from an external section via a network (see paragraph 103);

memory for storing said discount points to be associated with a user to which the said discount points are assigned (see paragraph 102); and

a processor (see paragraph 103),

wherein said memory further stores user identification data that identifies the user to which the said discount points are assigned to be associated with said discount points (see paragraph 106), and

a password associated with the said user identification data; and said processor obtains information sold password representing said user from an external section (see paragraph (see paragraph 105);

determines whether or not said memory stores said user identification data, that

identifies the user represented by said obtained information and said obtained password

to be associated with each other (see paragraph 105);

obtains goods data and use point data obtained by said receiving server from

said receiving, server via said network when determining that said memory stores said

user identification data and said password to be associated with each other (see

paragraph 105);

prevents said receiving server from obtaining said goods data or said user point

data when determining that said memory stores neither user identification data nor said

password to be associated with each other; decides discount points to be newly

assigned to said user based on the said goods data obtained by said receiving server

(see paragraph 106);

generates temporary balance data representing a result obtained by varying the

discount points stored in said memory by amount corresponding to a value obtained by

subtracting the discount points designated by use point data from the discount points

decided to be newly assigned to said user (see paragraph 106-107),

decides that goods represented by goods data obtained from said receiving

server is handled as goods that said user will purchase when settlement data

representing that settlement of the purchase of said goods is completed is supplied from

the external section (see paragraphs 103-107); and updates, in response to the

decision of goods that said user will purchase, said discount points stored by said

memory according to the result represented by said temporary balance data (see

paragraph 106)

whereby said *temporary balance data is temporarily* stored in said memory

before said settlement data is supplied from the external section.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was
> made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Breck</u> et

al (US 2004/0210449).

As per claim 10, <u>Breck</u> does not expressly teach:

The electronic settlement apparatus according to claim 1, wherein said processor

determines whether or not the price of goods represented by said goods data reaches a

predetermined minimum purchase amount, and decides that no discount point is

assigned to said user when determining that the price of goods does not reach the

predetermined minimum Purchase amount. However, Official notice is taken that

deciding the minimum amount of purchase in order to achieve a reward is old and well

known. For example, is it old and well known that online retailers provide free shipping

to customers that purchase more than a certain limit amount, such as fifty dollars. It

would have been obvious to a person of ordinary skill in the art at the time of applicant's invention was made, to know that Breck's participant merchants would only grant rewards to customers that purchase more than a minimum purchase amount because this would motivate customers to spend more money in the participating merchants.

Response to Arguments

6.   Applicant's arguments filed 11/02/2006 have been fully considered but they are not persuasive. The Applicant argues that Breck does not teach "temporary balance data" because in the Applicant's claimed invention the temporary balance is kept separately from data representing the current discount point and reflecting the value of temporary balance data into the current discount point in response to the completion of a transaction. The Examiner answers that Applicant is arguing about limitation not stated in the claims as Applicant's claims are not clear about the difference between discount points and use data and the time when settlement data and the temporary balance is updated. Applicant's claim simply recites "temporary balance data is temporarily stored in said memory before said settlement data is supplied to said processor". For purpose of art rejection, said limitation would be interpreted as meaning checking if there are sufficient points in a memory in order to settle a transaction with said points and Breck's paragraph 106 teaches said limitation.

The Applicant argues Breck does not prevent an illegal transaction that exceeds the balance of MR points from being conducted. The Examiner answers that Breck checks if the purchase amount is greater than the available amount, a denial is returned

(see paragraph 106). Therefore, contrary to Applicant's argument, <u>Breck</u> teaches Applicant's argument.

The Applicant argues that the Examiner has not provided a reference that allegedly teaches the elements acknowledge as missing from <u>Breck</u>. Thus, the Applicant request that the Examiner provide documentary evidence to support the taking of Official Notice as is required by the MPEP. The Examiner answers that statements such as, "the Examiner has not provided proof that this element is well known" or "applicant disagrees with the Examiner's taking Official Notice and hereby requests evidence in support thereof", are not adequate and do not shift the burden to the Examiner to provide evidence in support of the Official Notice. Allowing such statements to challenge Official Notice would effectively destroy any incentive on the part of the Examiner to use it in the process of establishing a rejection of notoriously well-known facts. Therefore, the Applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the Official Notice. Therefor, the presentation of a reference to substantiate the Official Notice is not deemed necessary. The Examiner's taking of Official Notice has been maintained.

Conclusion

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.
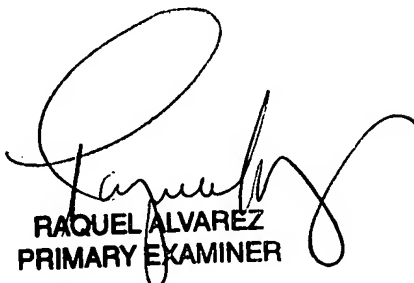
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra
January 24, 2007

RAQUEL ALVAREZ
PRIMARY EXAMINER